



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/797,465  
Applicant : Keith E. Metcalf et al.  
Filed : March 10, 2004  
Title : PARTITION SYSTEM

Confirmation No. 4278

TC/A.U. : 3635  
Examiner : Basil S. Katcheves

Atty. Docket No.: KIM0502-03  
Customer No. : 0832

DECLARATION OF J. DOUGLAS MITCHELL UNDER 35 C.F.R. §1.131

I, J. Douglas Mitchell, declare that:

1. I am a co-inventor of the invention defined by the claims in the present patent application, namely, U.S. Patent Application Serial No. 10/797,465, entitled "PARTITION SYSTEM", filed on March 10, 2004, which is a continuation of U.S. Patent Application Serial No. 10/453,187, entitled "PARTITION SYSTEM", filed on June 3, 2003, which claims the benefit under title 35 U.S.C. §119(e) of U.S. Provisional Patent Application Serial No. 60/386,775, entitled "PARTITION SYSTEM", filed on June 6, 2002, as well as U.S. Provisional Patent Application Serial No. 60/426,994, entitled "PARTITION SYSTEM", filed on November 15, 2002.

2. In an Office Action dated June 14, 2007, the Examiner rejected Claims 40, 42-48, 56 and 58-64 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,277,005 to Hellwig et al. ("Hellwig et al. '005") in view of U.S. Patent No. 6,851,226 to MacGregor et al. ("MacGregor et al. '226"). MacGregor et al. '226 has a priority filing date in the United States of February 15, 2002.

3. I was employed as a design engineer at Kimball International, Inc. ("Kimball"), the real party in interest in the present patent application, between November of 1990 and September of 2005. Between about March of 1997 and September of 2005, I worked at Kimball with Keith E. Metcalf, the other co-inventor in the present patent application.

4. Based on my work with Mr. Metcalf, I know that prior to January 8, 2002, Mr. Metcalf had reduced the invention defined by amended independent Claims 40, 56, and 61 to practice by building a prototype partition system at Kimball's facility in Jasper, Indiana, United States, embodying the invention defined by amended independent Claims 40, 56, and 61.

**Exhibits 1-3** attached hereto evidence that Mr. Metcalf had conceived and reduced to practice the present invention defined by independent Claims 40, 56, and 61 prior to the February 15, 2002 priority filing date of MacGregor et al. '226.

5. **Exhibit 1** is an email dated January 8, 2002 from Mr. Metcalf to one of the attorneys of record in the present application, Adam F. Cox, whose email address appears as "afcox.FW.BD". Attached to this email were two documents containing a series of photographs of the prototype partition system, and three movie files that were earlier taken by Mr. Metcalf at Kimball's facility in Jasper, Indiana, United States.

6. **Exhibit 2** is a series of five photographs, labeled Photos 1-5, which have been selected from the series of photographs that Mr. Metcalf sent to Mr. Cox in the email of **Exhibit 1**, with annotations added. Photos 1-5 each bear a date stamp of December 10, 2001.

7. **Exhibit 3** is a CD containing the series of photographs of the prototype partition system and one of the three movie files that Mr. Metcalf sent to Mr. Cox in the email of **Exhibit 1**.

8. Photos 1-5 each show the prototype partition system, which included a framework having a plurality of frame members, colored black. The framework had opposing vertical sides and a framework interior disposed between the opposing vertical sides.

9. As shown in Photos 1-5, at least a pair of horizontal track members, colored silver or grey, were mounted to a side of the framework and were disposed outwardly of the framework interior. The track members included mutually-facing tile receiving structures in the form of upwardly and downwardly-opening tile edge receiving spaces, similar to tracks 146 shown in Fig. 13A of the present patent application.

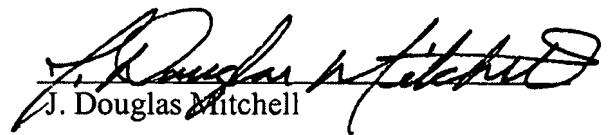
10. Referring to Photos 1-3, at least one tile including upper and lower edges was mounted to the framework by sliding receipt and retention of the upper and lower edges of the tile within the tile-retaining structures of the track members. The tile included a storage area extending into the framework interior.

11. Referring to Photos 1-3, one of the tiles included a storage bin mounted to the tile, the storage bin movable between a first position in which the storage bin was disposed within the storage area of the tile and a second position in which at least a portion of the storage bin was disposed outwardly of the storage area of the tile. The movie file of **Exhibit 3** depicts a portion of the above-described prototype partition system, and shows a person opening the storage bin of the foregoing tile, removing a paper file, and then closing the storage bin.

12. I conceived the invention defined by dependent Claims 42, 43, 45-48, 58, 59, 62, 63, 65 and 66 along with Mr. Metcalf.

13. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 8-16-2007

  
J. Douglas Mitchell



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DECLARATION OF KEITH E. METCALF UNDER 35 C.F.R. §1.131

I, Keith E. Metcalf, declare that:

1. I am a co-inventor of the invention defined by the claims in the present patent application, namely, U.S. Patent Application Serial No. 10/797,465, entitled "PARTITION SYSTEM", filed on March 10, 2004, which is a continuation of U.S. Patent Application Serial No. 10/453,187, entitled "PARTITION SYSTEM", filed on June 3, 2003, which claims the benefit under title 35 U.S.C. §119(e) of U.S. Provisional Patent Application Serial No. 60/386,775, entitled "PARTITION SYSTEM", filed on June 6, 2002, as well as U.S. Provisional Patent Application Serial No. 60/426,994, entitled "PARTITION SYSTEM", filed on November 15, 2002.
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3. I have been employed as a product designer at Kimball International, Inc. ("Kimball"), the real party in interest in the present patent application, since March of 1997. Between about March of 1997 and September of 2005, I worked at Kimball with J. Douglas Mitchell, the other co-inventor in the present patent application.

4. Prior to December 31 2001, I had conceived the invention defined by amended independent Claim 40, in particular, a partition system, including a framework including opposing vertical sides and a framework interior disposed between the opposing vertical sides; at least a pair of track members mounted to a side of the framework and disposed outwardly of the framework interior, the track members including mutually-facing tile receiving structures; and at least one tile including upper and lower edges, the tile mounted to the framework by sliding receipt of the upper and lower edges within the tile-retaining structures of the track members, the tile including a storage area extending into the framework interior.

5. Prior to December 31 2001, I had also conceived the invention defined by amended independent Claim 56, in particular, a partition system, including a framework including opposing vertical sides and a framework interior disposed between the opposing vertical sides; at least a pair of track members mounted to a side of the framework and disposed outwardly of the framework interior, the track members including mutually-facing tile receiving structures; at least one tile including upper and lower edges, the tile mounted to the framework by receipt of the upper and lower edges within the tile-retaining structures of the track members, the tile including a storage area extending into the framework interior; and a storage bin mounted to the tile and movable between a first position in which the storage bin is disposed within the storage area and a second position in which at least a portion of the storage bin is disposed outwardly of the storage area.

6. Prior to December 31 2001, I had further conceived the invention defined by amended independent Claim 61, in particular, a partition system, including a framework including opposing vertical sides and a framework interior disposed between the opposing vertical sides; at least a pair of track members mounted to a side of the framework and disposed outwardly of the framework interior, at least one of the track members including a channel opening outwardly with respect to the framework; at least one tile including upper and lower edges, the tile mounted to the framework by retention of the upper and lower edges of the tile between the track members, the tile including a storage area extending into the framework interior.

7. Prior to January 8, 2002, I had also reduced the invention defined by amended independent Claims 40, 56, and 61 to practice by building a prototype partition system at Kimball's facility in Jasper, Indiana, United States, embodying the invention defined by amended independent Claims 40, 56, and 61. **Exhibits 1-3** attached hereto evidence that I had conceived and reduced to practice the present invention defined by independent Claims 40, 56, and 61 prior to the February 15, 2002 priority filing date of MacGregor et al. '226.

8. **Exhibit 1** is an email dated January 8, 2002 from myself to one of the attorneys of record in the present application, Adam F. Cox, whose email address appears as "afcox.FW.BD". Attached to this email were two documents containing a series of photographs of the prototype partition system, and three movie files that were earlier taken by myself at Kimball's facility in Jasper, Indiana, United States.

9. **Exhibit 2** is a series of five photographs, labeled Photos 1-5, which have been selected from the series of photographs that I sent to Mr. Cox in the email of **Exhibit 1**, with annotations added. Photos 1-5 each bear a date stamp of December 10, 2001.

10. **Exhibit 3** is a CD containing the series of photographs of the prototype partition system and one of the three movie files that I sent to Mr. Cox in the email of **Exhibit 1**.

11. Photos 1-5 each show the prototype partition system, which included a framework having a plurality of frame members, colored black. The framework had opposing vertical sides and a framework interior disposed between the opposing vertical sides.

12. As shown in Photos 1-5, at least a pair of horizontal track members, colored silver or grey, were mounted to a side of the framework and were disposed outwardly of the framework interior. The track members included mutually-facing tile receiving structures in the form of upwardly and downwardly-opening tile edge receiving spaces, similar to tracks 146 shown in Fig. 13A of the present patent application.

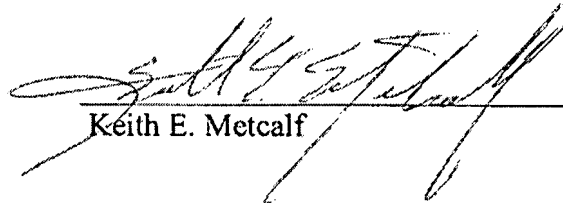
13. Referring to Photos 1-3, at least one tile including upper and lower edges was mounted to the framework by sliding receipt and retention of the upper and lower edges of the tile within the tile-retaining structures of the track members. The tile included a storage area extending into the framework interior.

14. Referring to Photos 1-3, one of the tiles included a storage bin mounted to the tile, the storage bin movable between a first position in which the storage bin was disposed within the storage area of the tile and a second position in which at least a portion of the storage bin was disposed outwardly of the storage area of the tile. The movie file of **Exhibit 3** depicts a portion of the above-described prototype partition system, and shows a person opening the storage bin of the foregoing tile, removing a paper file, and then closing the storage bin.

15. I also conceived the invention defined by dependent Claims 44, 60 and 64. I further conceived the invention defined by dependent Claims 42, 43, 45-48, 58, 59, 62, 63, 65 and 66 along with the other co-inventor in the present application, J. Douglas Mitchell.

16. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 8-16-2007

  
Keith E. Metcalf

**Cox, Adam F.**

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**From:** kmetcal@kimball.com  
**Sent:** Tuesday, January 08, 2002 8:53 AM  
**To:** afcox.FW.BD  
**Subject:** Mainstay (KS-105)

Here is are some photos and animations of our Mainstay system.

<<MainstayPrototype.jpg>> <<Mainstay Contact Sheet.jpg>> <<MvFlipOut  
File.mpg>> <<MvFlipUp Worksurface.mpg>> <<MvPassThroughTrash.mpg>>

Thanks,

Keith Metcalf..

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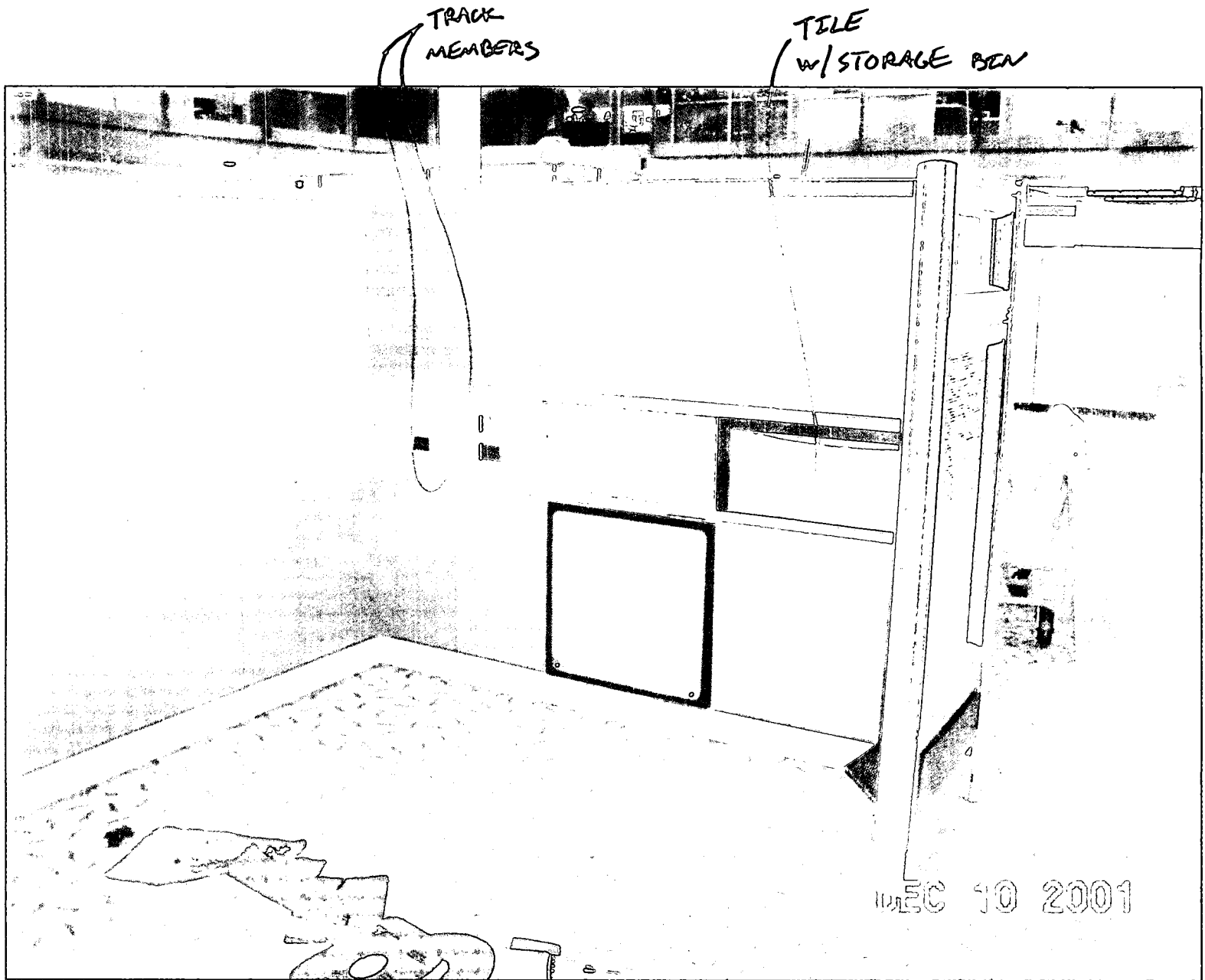


PHOTO 1

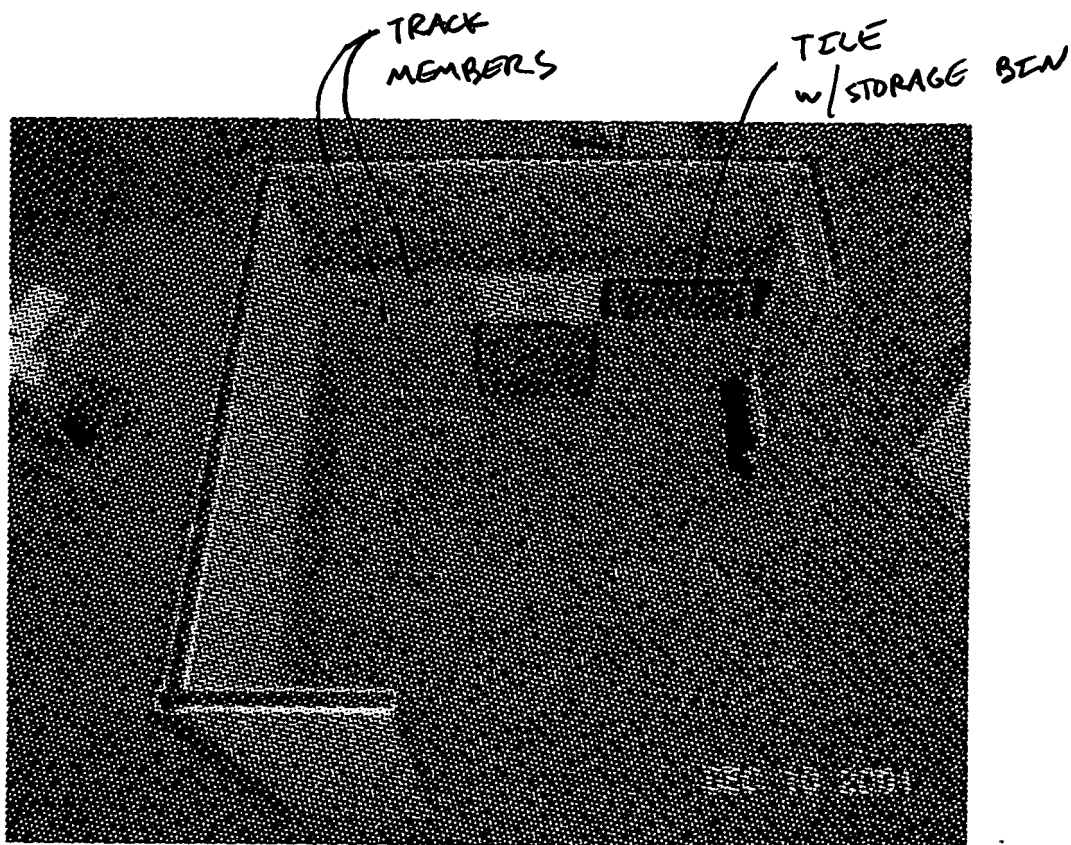


PHOTO 2

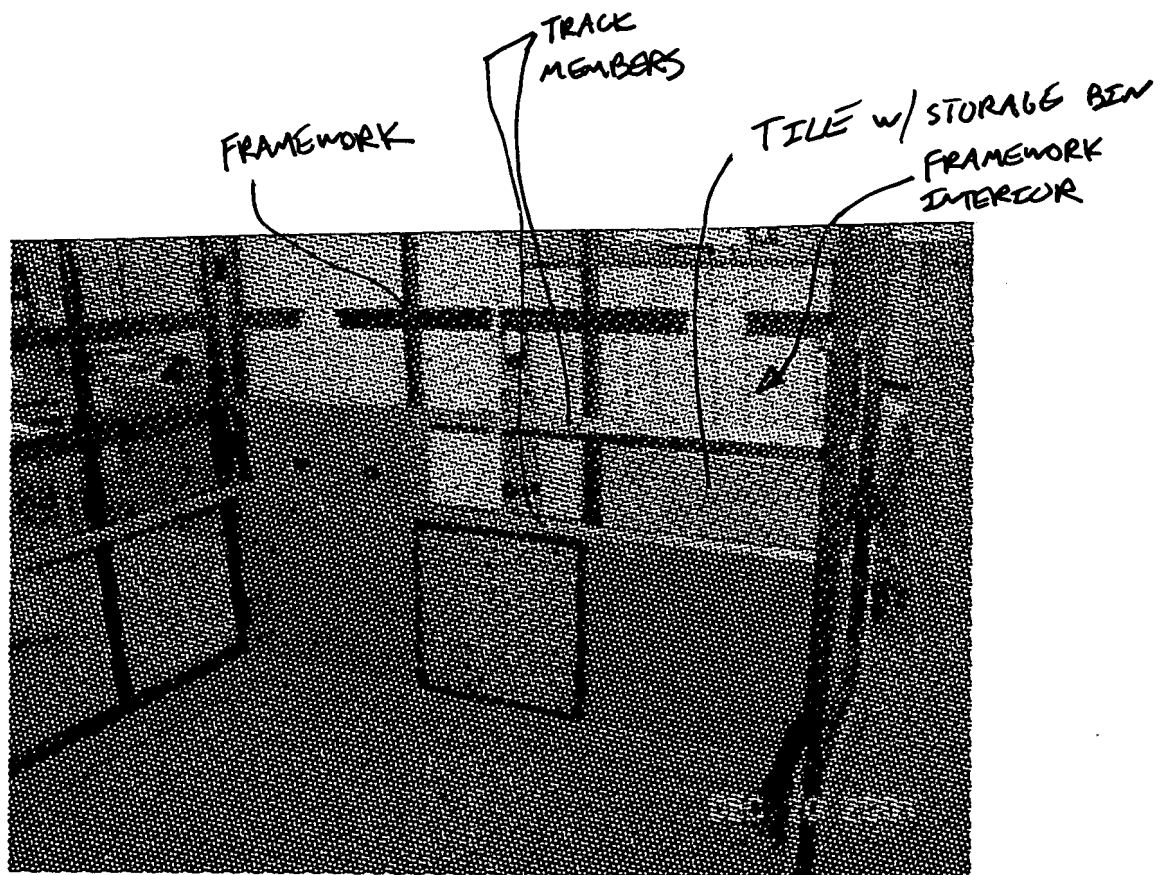


PHOTO 3

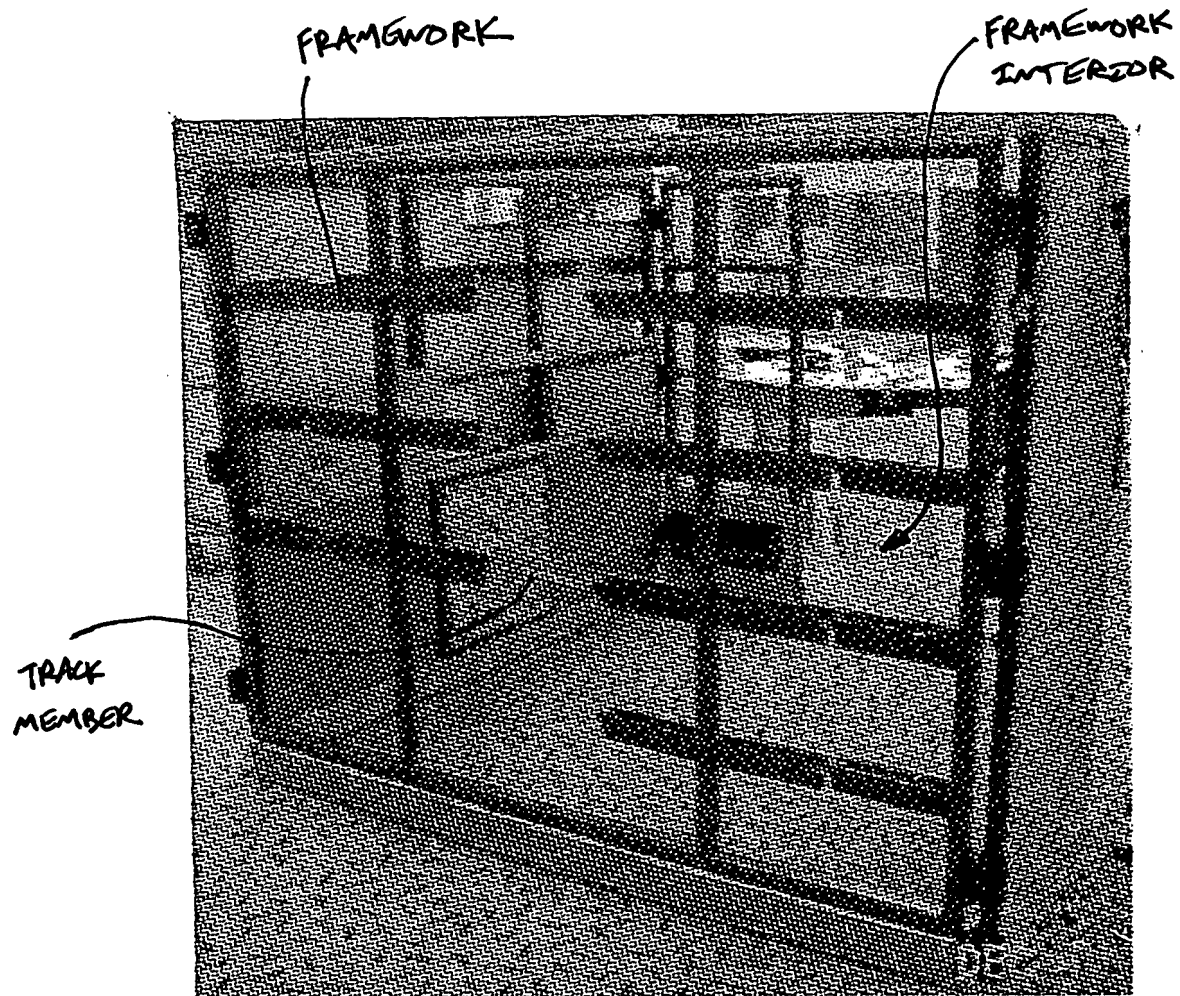


PHOTO 4

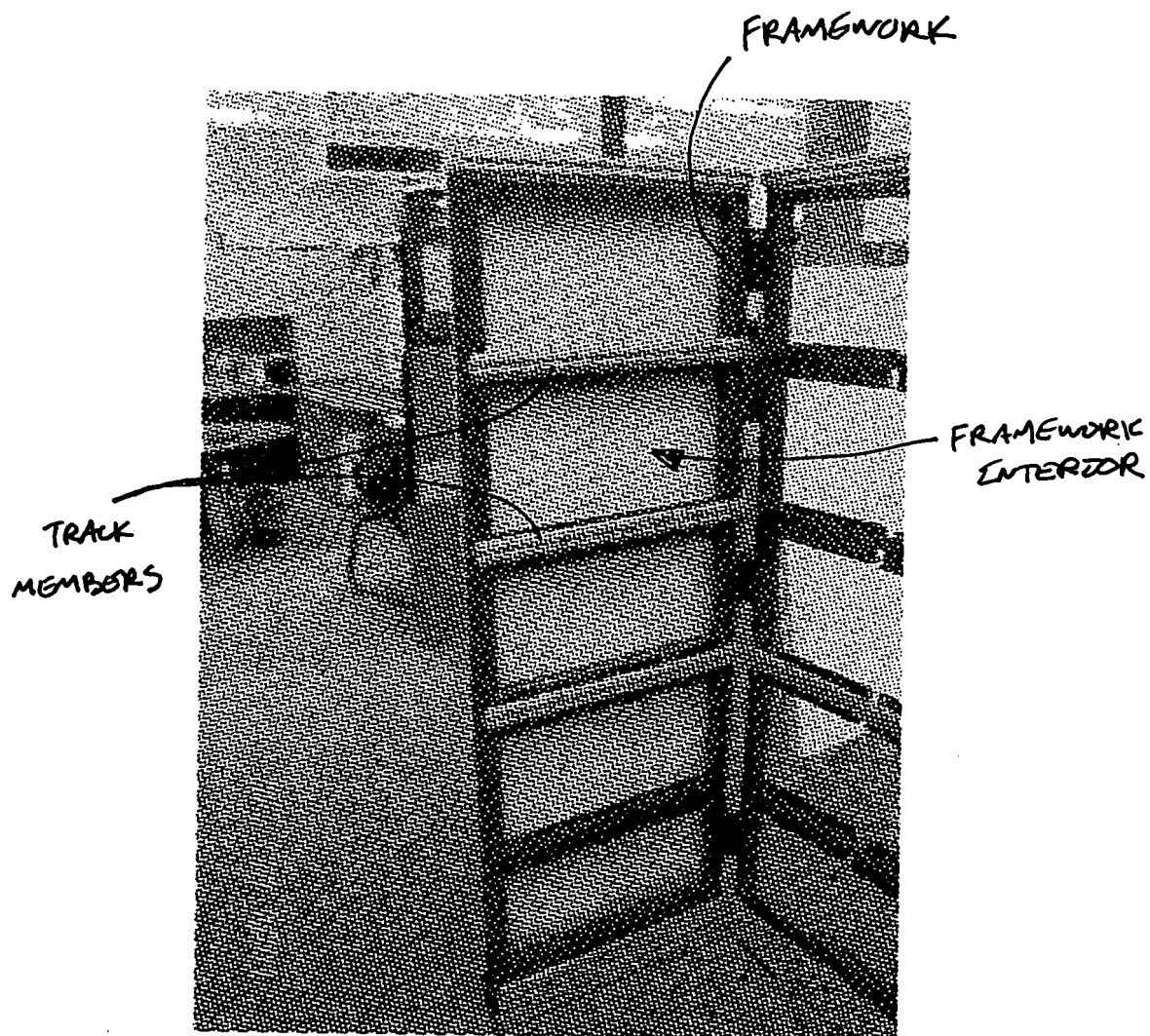


PHOTO 5